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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,920	12/11/2001	Albert C. Ting	VGEN.005A	7542
20995	7590	02/17/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			PREBILIC, PAUL B	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3738	

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,920

Applicant(s)

TING ET AL.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6,8-11,20,21,23-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) 32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-6,8-11,20,21 and 26 is/are allowed.
- 6) ☒ Claim(s) 23-25,27,28,30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Newly submitted claim 32 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The original claims were drawn to an intraocular lens, but new claim 32 is directed to a method of implanting an intraocular lens. Since the intraocular lens of the original and present claims can be used in a materially different method of use, the invention claimed considered to be distinct from the method of claim 32.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 32 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-25, 27, 28, 30, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Turley (US 4,892,543). Turley anticipates the claim language where the anterior portion as claimed is met by component (42) of Turley, the posterior portion as claimed is met by component (44) with viewing element (60) that is clearly larger. The posterior and anterior orientation is considered to be merely a statement of intended use such that the device is capable of being used in a different orientation; see Figure 2

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and column 2, line 12 to column 4, line 9. The biasing element as claimed is arm (54).

The dioptic power of most surfaces are less than 30 diopters and all surfaces are 30 diopters or less; see column 4, lines 30-38.

With regard to claim 24, Applicant is directed to column 4, lines 60-64. Since the refractive portion is within the 20.0 mm size disclosed by Turley, than the refractive portion of 3 mm as claimed or less is inherently located in that 20.0 mm zone of Turley.

With regard to claim 27, the surface (50) is a refractive surface because it is curved. It must be below 30 diopters because the lens provides a total of 30 diopters in the state shown in Figure 2 that is provided by surface (48).

With regard to claim 28, depending upon what direction the light goes through ring (64), a positive refractive power is provided due to the curved surfaces thereof.

Allowable Subject Matter

Claims 2-6, 8-11, 20-21, and 26 are allowed over the prior art of record.

Response to Arguments

Applicant's arguments filed December 7, 2005 have been fully considered but they are not persuasive.

In response to the traversal of the Section 102 rejection of Turley that Turley's device accommodates in an opposite fashion as the claimed invention, the Examiner asserts that the claimed structure is read on by Turley since Turley discloses all the structural limitations of the claims regardless of how Turley uses the device; see MPEP 2131.05 that is incorporated herein by reference. Since the intended use does not

result in a structural difference, the claim language is considered to be fully met by Turley.

The Applicant argues that the accommodation state of Turley is actually the unaccommodation state of the present invention. However, the Examiner asserts that accommodation is merely an adjustment to focus an image in an eye so the term is one of relative degree that depends upon where and how the device is used. In other words, the accommodation state could be when the ciliary muscles are relaxed or partially or fully flexed depending upon what might focus an image on the retina of an eye. The shape and size of the eye (i.e. intended use) are factors that cannot limit the claim structure because they are external to the claimed structure.

Finally, the Applicant argues that MPEP section 2143.01 points out that that the device can not be used in way that renders it inoperable. However, the Examiner notes that this section is dealing with Section 103 rejections where one has to modify the base reference by a teaching of the prior art. Since the present claims are only rejected under Section 102, this argument is not relevant to the present rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
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